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1660 LINCOLN ST SUITE 2050 DENVER, CO 80264			HUNTSINGER, PETER K	
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## Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)		
	09/960,162	WHISNANT ET AL.		
Office Action Summary	Examiner	Art Unit		
	Peter K. Huntsinger	2625		
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address		
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period value or exply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be timused and will expire SIX (6) MONTHS from a cause the application to become ABANDONE	N. sely filed the mailing date of this communication. D (35 U.S.C. § 133).		
Status				
Responsive to communication(s) filed on <u>31 O</u> This action is <b>FINAL</b> . 2b) ☐ This     Since this application is in condition for allowar closed in accordance with the practice under E	action is non-final.  nce except for formal matters, pro			
Disposition of Claims				
4) ⊠ Claim(s) <u>1-86</u> is/are pending in the application. 4a) Of the above claim(s) is/are withdray 5) □ Claim(s) is/are allowed. 6) ⊠ Claim(s) <u>1-86</u> is/are rejected. 7) □ Claim(s) is/are objected to. 8) □ Claim(s) are subject to restriction and/o	wn from consideration.			
Application Papers				
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) accomplicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Examine	epted or b) objected to by the I drawing(s) be held in abeyance. See ion is required if the drawing(s) is ob	e 37 CFR 1.85(a). lected to. See 37 CFR 1.121(d).		
Priority under 35 U.S.C. § 119				
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some col None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.				
		•		
Attachment(s)  1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Do 5) Notice of Informal P 6) Other:	ate		

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#### **DETAILED ACTION**

### Response to Arguments

1. Applicant's arguments with respect to claims 1-86 have been considered but are moot in view of the new ground(s) of rejection.

## Claim Rejections - 35 USC § 112

- 2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
  - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 recites the limitation "said one of said fulfillment centers" in lines 6 and 7. There is insufficient antecedent basis for this limitation in the claim. The language should be changed to "said <u>at least</u> one of said fulfillment centers" to be consistent with the independent claim 1.

# Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 16, and 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 16, and 29 drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

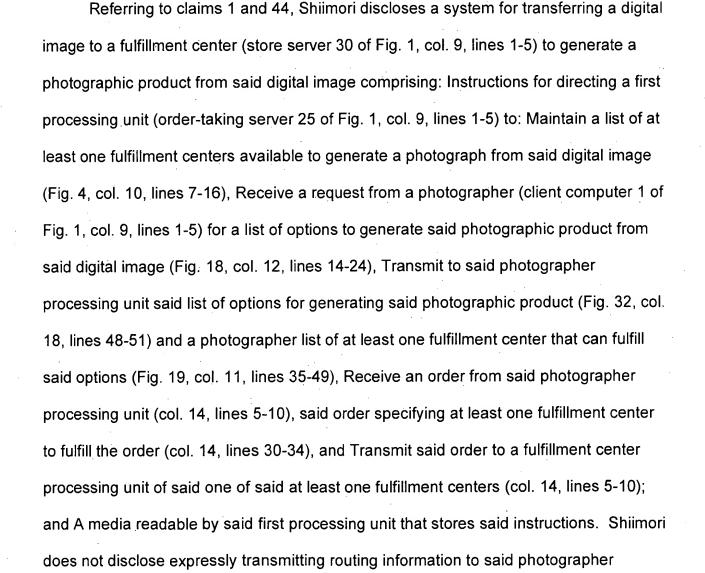
Claims 1, 16, and 29, while defining a method comprising instructions, does not define a "computer-readable medium" and is thus non-statutory for that reason. A method comprising instructions can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending claim 1 to state "a computer readable medium embodying instructions for directing a first processing unit to" in order to make the claim statutory. The limitation "a media readable by said first processing unit that stores said instructions" should be removed. Likewise, claims 16 and 29 should state a computer readable medium embodying the instructions.

### Claim Rejections - 35 USC § 103

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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6. Claims 1-3, 5, 7, 16-20, 22, 24-30, 39-46, 48, 50, 59-63, 65, 67-73, and 82-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori Patent 6,853,461 and further in view of Cocotis et al. Patent 6,980,964.



processing unit to transmit images to the fulfillment center. Cocotis et al. disclose

Transmitting routing information to said photographer processing unit wherein said

routing information is for transmitting said digital image to a one of said at least one

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fulfillment centers to process said order (col. 4, lines 55-67). It is inherent that the system of Cocotis et al. transmits routing information to the photographer processing unit for transmitting images. A website maintained by the photo shop sent to the patron includes a URL which would be routing information. Shiimori and Cocotis are combinable because they are from the same field of photograph ordering systems. At the time of the invention, it would have obvious to a person of ordinary skill in the art to transmit routing information for transmitting images. The motivation for doing so would have been to allow the fulfillment center to provide its own website interface. Therefore, it would have been obvious to combine Cocotis et al. with Shiimori to obtain the invention as specified in claims 1 and 44.

Referring to claims 2 and 45, Cocotis et al. disclose wherein said instructions further comprise: Instructions for directing said first processing unit to: Receive said digital image from said photographer processing unit (col. 14, lines 5-10).

Referring to claims 3 and 46, Cocotis et al. disclose wherein said instructions to process said order further comprise: Instructions for directing said first processing unit to: Transmit said digital image to said fulfillment center processing unit (col. 14, lines 5-10).

Referring to claims 5 and 48, Shiimori discloses wherein said instructions for directing a first processing unit further comprise: Instructions for directing said first processing unit to: Determine said one of said at least one fulfillment centers to process said order from parameters received in said order responsive to receiving said order (col. 14, lines 5-10)

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Referring to claims 7 and 50, Shiimori discloses charging for printing photographs, but does not disclose expressly debiting a photographer account. Cocotis et al. disclose wherein said instructions further comprise: Instructions for directing said first processing unit to: debit a photographer account responsive to receiving said order (col. 7-8, lines 63-67, 1-6). Shiimori and Cocotis are combinable because they are from the same field of photograph ordering systems. At the time of the invention, it would have obvious to a person of ordinary skill in the art to debit a photographer account after receiving an order. The motivation for doing so would have been to extend a line of credit to the customer. Therefore, it would have been obvious to combine Cocotis et al. with Shiimori to obtain the invention as specified in claims 7 and 50.

Referring to claims 16 and 59, Shiimori discloses Instructions for directing a photographer processing unit to: Establish a connection with said first processing unit, Receive said request for said list of options of said one of said at least one fulfillment centers, Transmit said request to said first processing unit, Receive said list of options from said first processing unit, and Display said list of options (Fig. 18, col. 12, lines 14-24); Receive an input specifying at least one fulfillment center to fulfill an order (col. 11, lines 35-49); and A second media readable by said photographer processing unit that stores said instructions.

Referring to claims 17 and 60, Shiimori discloses wherein said instructions for directing said photographer processing unit further comprise: Instructions for directing said photographer processing unit to: Receive an input of said order, and Transmit said order to said first processing unit (col. 14, lines 5-10).

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Referring to claims 18 and 61, Cocotis et al. disclose wherein said instructions for directing said photographer processing unit further comprise: Instructions for directing said photographer processing unit to: Receive said routing information from said first processing unit (col. 4, lines 55-67). It is inherent that the system of Cocotis et al. transmits routing information to the photographer processing unit for transmitting images. A website maintained by the photo shop sent to the patron includes a URL which would be routing information.

Referring to claims 19 and 62, Cocotis et al. disclose wherein said instructions for directing said photographer processing unit to: instructions for directing said processing unit to: transmit said digital image to said first processing unit responsive receiving said receiving said routing information (col. 7, lines 26-28).

Referring to claims 20 and 63, Cocotis et al. disclose wherein said instructions for directing said photographer processing unit further comprises: Instructions for directing said photographer unit to: Transmit said digital image to said one of said at least one fulfillment center using said routing information responsive to receiving said routing information (col. 7, lines 26-28).

Referring to claims 22 and 65, Shiimori discloses wherein said instructions for directing said photographer processing unit to: Instructions for directing said photographer unit to: Transmit an account identification to said first processing unit responsive to transmitting said order (col. 14, lines 5-10).

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Referring to claims 24 and 67, Shiimori discloses wherein said request includes parameters for selecting said one of said at least one fulfillment centers to process said order (Fig. 18, col. 12, lines 14-24).

Referring to claims 25 and 68, Shiimori discloses disclose wherein said parameters include a location of a fulfillment center (col. 3, lines 53-58).

Referring to claims 26 and 69, Cocotis et al. disclose wherein said parameters include sizes for said photographic product (Fig. 18, col. 12, lines 14-24).

Referring to claims 27 and 70, Shiimori discloses wherein said parameters include graphics available for said photographic product (Fig. 18, col. 12, lines 14-24).

Referring to claims 28 and 71, Shiimori discloses wherein said request includes parameters for selecting a fulfillment center, but does not disclose expressly wherein said parameters include price range. Cocotis et al. disclose wherein said parameters include a range of prices for said photographic product (col. 10, lines 29-33). Shiimori and Cocotis are combinable because they are from the same field of photograph ordering systems. At the time of the invention, it would have obvious to request fulfillment centers based on price range. The motivation for doing so would have been to provide the user a list of fulfillment centers that are within the desired price range. Therefore, it would have been obvious to combine Cocotis et al. with Shiimori to obtain the invention as specified in claims 28 and 71.

Referring to claims 29 and 72, Shiimori discloses Instructions for directing a fulfillment center processing unit to: Receive said order from said first processing unit, Receive said digital image (col. 14, lines 5-10), and Process said order to generate said

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photographic product (col. 14, lines 11-18); and A media readable by said fulfillment center processing unit that stores said instructions.

Referring to claims 30 and 73, Shiimori discloses wherein said instructions for directing said fulfillment center processing unit further comprising: Instructions for directing said processing unit to: Store said digital image to a memory (col. 23, lines 14-19).

Referring to claims 39 and 82, Cocotis et al. disclose wherein said instruction for directing said fulfillment center processing unit further comprise: Instructions for directing said fulfillment center processing unit to: Receive said digital image from a photographer processing unit (col. 7, lines 26-28).

Referring to claims 40 and 83, Shiimori discloses wherein said list of options includes photographic product sizes (col. 18, lines 39-43).

Referring to claims 41 and 84, Shiimori discloses a list of options but does not disclose expressly wherein said options include types of paper. Cocotis et al. disclose wherein said list of options includes types of paper available for said photographic product (col. 7, lines 29-32). Shiimori and Cocotis are combinable because they are from the same field of photograph ordering systems. At the time of the invention, it would have obvious to include a paper type option. The motivation for doing so would have been to allow the customer to select the desired paper type for their photographs. Therefore, it would have been obvious to combine Cocotis et al. with Shiimori to obtain the invention as specified in claims 41 and 84.

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Referring to claims 42 and 85, Shiimori discloses wherein said list of options includes graphics available to said digital image to generate said photographic product (col. 13, lines 16-21).

Referring to claims 43 and 86, Shiimori discloses wherein said list of options includes fulfillment centers that provide particular options (col. 11, lines 35-49).

7. Claims 4, 6, 8-14, 31-34, 47, 49, 51-57, and 74-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori Patent 6,853,461 and Cocotis et al. Patent 6,980,964 as applied to claims 1, 7, 29, 30, 44, 50, 72, and 73 above, and further in view of well known prior art.

Referring to claims 4 and 47, Shiimori discloses said digital image being transmitted to said fulfillment center processing unit, but do not disclose expressly receiving a confirmation after transmission. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to receive a confirmation after a transmission (See MPEP 2144.03). The motivation for doing so would have been to notify the photo shop that the images have been sent correctly.

Referring to claims 6 and 49, Shiimori discloses sending an order, but do not disclose expressly receiving a confirmation after the order is processed. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to receive a confirmation after an order is processed (See MPEP 2144.03). The motivation for doing so would have been to notify the photo shop that the images have been processed correctly.

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Referring to claims 8 and 51, Cocotis et al. disclose debiting a photographer account, but do not disclose expressly receiving funds and transferring then to an account. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to deposit funds into an account (See MPEP 2144.03). The motivation for doing so would have been to establish a line of credit for the photographer.

Referring to claims 9 and 52, Cocotis et al. disclose wherein said funds are transferred electronically (col. 7, lines 33-35).

Referring to claims 10 and 53, Cocotis et al. disclose transmitting said order but do not disclose expressly transmitting responsive to receiving funds. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to receive funds before providing a service (See MPEP 2144.03). The motivation for doing so would have been to verify the patron has the money for the service.

Referring to claims 11 and 54, Cocotis et al. disclose debiting a photographer account, but do not disclose expressly receiving funds and transferring then to an account. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to deposit funds into an account (See MPEP 2144.03). The motivation for doing so would have been to establish a line of credit for the photographer.

Referring to claims 12 and 55, Cocotis et al. disclose debiting a photographer account, but do not disclose expressly periodically debiting an account. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to

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periodically debit an account (See MPEP 2144.03). The motivation for doing so would have been to charge a monthly fee for using a service.

Referring to claims 13 and 56, Cocotis et al. disclose wherein said instructions for directing said first processing unit further comprises: Instructions for directing said first processing unit to: Maintain a count of a number of orders that said one of said at least one fulfillment centers receives (col. 8, lines 14-23).

Referring to claims 14 and 57, Cocotis et al. disclose maintaining a count of a number of orders that said one of said at least one fulfillment centers receives, but do not disclose expressly debiting a charge after the count reaches a predetermined number. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to charge after a count has reached a predetermined number (See MPEP 2144.03). The motivation for doing so would have been to avoid having to charge a customer for each transaction.

Referring to claims 31 and 74, Shiimori discloses storing said digital image at the fulfillment center, but do not disclose expressly deleting the image after the processing the order. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to delete an image after an order has been completed (See MPEP 2144.03). The motivation for doing so would have been to obtain memory space by deleting unneeded information.

Referring to claims 32 and 75, Shiimori discloses storing said digital image at the fulfillment center, but do not disclose expressly deleting the image after the a period of time. Official Notice is taken that it is well known and obvious to a person of ordinary

skill in the art to delete a data after a period of time has passed (See MPEP 2144.03).

The motivation for doing so would have been to clear a system's RAM at defined intervals.

Referring to claims 33 and 76, Shiimori discloses ordering digital images, but do not disclose expressly transmitting a status periodically. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to periodically transmit order status (See MPEP 2144.03). The motivation for doing so would have been to notify the photo shop whether the order is completed or not.

Referring to claims 34 and 77, Shiimori discloses a plurality of fulfillment centers, but do not disclose expressly transmitting an availability of the fulfillment centers.

Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to transmit an availability of a service (See MPEP 2144.03). The motivation for doing so would have been to notify the photo shop whether a particular service is available or not.

8. Claims 15, 21, 58, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori Patent 6,853,461 and Cocotis et al. Patent 6,980,964 as applied to claims 1, 20, 44, and 63 above, and further in view of Arledge, Jr. et al. Patent 6,535,294.

Referring to claims 15 and 58 Shiimori discloses a list of fulfillment centers but do not disclose expressly a web page listing said fulfillment centers. Arledge, Jr. et al. disclose maintaining a web page listing said fulfillment centers with hyper-linked text

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pointing to web pages listing said options for said fulfillment centers (Fig. 7, col. 14, lines 16-31). Shiimori and Arledge, Jr. et al. are combinable because they are from the same field of photograph ordering systems. At the time of the invention, it would have obvious to a person of ordinary skill in the art to maintain a web page of fulfillment centers with links to their products. The motivation for doing so would have been to provide an interface for a customer to choose a fulfillment center and view the products. Therefore, it would have been obvious to combine Arledge, Jr. et al. with Shiimori and Cocotis et al. to obtain the invention as specified in claims 15 and 58.

Referring to claims 21 and 64, Shiimori discloses transmitting said digital image to said first processing unit, but does not disclose expressly a transmitting a confirmation. Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to transmit a confirmation after a transmission (See MPEP 2144.03). The motivation for doing so would have been to determine if the images have been sent correctly.

9. Claims 23, 35-38, 66, and 78-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimori Patent 6,853,461 and Cocotis et al. Patent 6,980,964 as applied to claims 17, 29, 60, and 72 above, and further in view of Garfinkle et al. Patent 6,017,157.

Referring to claims 23 and 66, Shiimori discloses ordering digital images, but do not disclose expressly a graphic instruction set. Garfinkle et al. disclose wherein said order includes a graphic instruction set for said photograph (col. 5, lines 20-29).

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Shiimori and Garfinkle et al. are combinable because they are from the same field of photograph ordering systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow a graphic instruction set for a photograph. The motivation for doing so would have been to allow customization of a photograph to the particular desires of a customer. Therefore, it would have been obvious to combine Garfinkle et al. with Shiimori and Cocotis et al. to obtain the invention as specified in claims 23 and 66.

Referring to claims 35 and 78, Shiimori discloses generating a digital image with a fulfillment center, but do not disclose expressly generating a proof from a digital image and a graphic set. Garfinkle et al. disclose generating a proof from said digital image and a graphic instruction set (col. 8, lines 13-19). Shiimori and Garfinkle et al. are combinable because they are from the same field of photograph ordering systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art generate a proof from a digital image and graphic instruction set. The motivation for doing so would have been to evaluate the images for errors before printing the order. Therefore, it would have been obvious to combine Garfinkle et al. with Shiimori and Cocotis et al. to obtain the invention as specified in claims 35 and 78.

Referring to claims 36 and 79, Garfinkle et al. disclose instructions for directing said fulfillment center processing unit further comprises: Instructions for directing said fulfillment center processing unit to: Read said graphic instruction set from said order (col. 5, lines 20-29).

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Referring to claims 37 and 80, Garfinkle et al. disclose instructions for directing said fulfillment center processing unit further comprises: Instructions for directing said fulfillment center processing unit to: Receive said graphic instruction set from a photographer processing unit (col. 5, lines 20-29).

Referring to claims 38 and 81, Shiimori discloses wherein said instructions for directing said fulfillment processing unit further comprising: Instructions for directing said fulfillment center processing unit to: Receive said digital image from said first processing unit (col. 14, lines 5-10).

#### Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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